

### **REMARKS**

The Official Action mailed October 20, 2004, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statement filed on January 22, 2004, and March 10, 2004. However, the Applicants have not received acknowledgment of the Information Disclosure Statement filed on January 8, 2004. The Applicants respectfully request that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of this Information Disclosure Statement.

In pages 10 and 11 of the *Amendment* filed July 27, 2004, the Applicants presented detailed reasons why it was improper for the Examiner to refuse to consider the IDS filed January 8, 2004. These arguments were as follows:

Regarding the Information Disclosure Statement filed January 8, 2004, the Official Action asserts that "a preliminary review shows that the IDS contains references that are not material to patentability and are superfluous to the determination of patentability" and concludes that since "review of voluminous non-pertinent material places a burden on this Office, Applicant's IDS will therefore not be considered" (pages 4-5, Paper No. 0404, citing 37 CFR § 1.56, MPEP § 609, MPEP § 2004, ¶13, and, specifically, the *Penn Yan* case). The Applicants respectfully disagree and traverse the above-referenced assertions and decision.

37 CFR § 1.56 clearly states that the "duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98." The Applicants respectfully submit that all information known to be material to patentability of any claim in the present application has been submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. Furthermore, Rule 97 makes clear that the Patent office "shall" consider any IDS that is properly filed in accordance with that section. That is, consideration by the Office is mandatory, not optional. The Applicants are further unaware of any rule that provides for non-consideration of an IDS based its size or materiality

of the information, as asserted in the Official Action. The Applicants respectfully submit that the IDS filed January 8, 2004, fully complies with the rules and must be considered by the Examiner in a timely manner.

Furthermore, regarding the *Penn Yan* case, a patent was held unenforceable due to inequitable conduct resulting from the intentional burying of a highly material reference in a large IDS. Although *Penn Yan* notes in dicta that long lists of references should be avoided, the Applicants in no way intend to bury a highly material reference. The Applicants have identified the references cited in the IDS filed January 8, 2004, as possibly being material to the subject application. The Applicants are under an obligation to provide any information that may be material to patentability. In fact, as noted in MPEP § 2004, ¶10, **"When in doubt, it is desirable and safest to submit information. Even though the attorney, agent, or applicant doesn't consider it necessarily material, someone else may see it differently and embarrassing questions can be avoided"** (emphasis added). Furthermore, 37 CFR 1.97(h) makes clear that the filing of an IDS is not an admission (or representation) that the information contained therein is material to patentability and thus contemplates that non-material information may be submitted as suggested by the MPEP. It is not the Applicants' duty to insure that every reference submitted is material to patentability, but rather that any reference that may be material to patentability be submitted so that it may be fully considered by the Examiner. The cited references may be material to patentability and are appropriate for consideration by the Examiner. The obligation to consider the references is not optional, but mandatory by the Office and consideration is requested.

Rather than providing a response to the Applicants' arguments, the Examiner merely dismisses the entire matter by asserting, without any support from the MPEP or the Rules (37 CFR), that "Applicant's IDS dated 8 January 2004 will not be considered since it represents a burden" (page 4, Paper No. 1004). As explained in detail above, the Examiner's refusal to consider the IDS filed January 8, 2004, is not consistent with the MPEP or the Rules (37 CFR). The Applicants further submit that "An information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner assigned to the application" (MPEP 609, emphasis added). The Applicants respectfully submit that the IDS filed January 8, 2004, fully complies with 37 CFR 1.97 and 37 CFR 1.98. Therefore, the IDS filed January 8, 2004, must be considered by the Examiner.

While the Applicants respectfully submit that the IDS filed January 8, 2004, fully complies with the MPEP and the Rules and must be considered by the Examiner, it appears that the Examiner is of the belief that the IDS represents "a burden." As such, it appears that the Examiner may not have been given enough time to complete his examination of the present application, which must include consideration of all information properly submitted by the Applicants in accordance with 37 CFR 1.97 and 1.98. The Applicants believe that the Examiner may request that his SPE grant additional examination time for the present application. This time may be reported on the Biweekly Time Worksheet, PTO-690E, using an appropriate so-called "690E Code." For example, the Examiner may request Search and Examination time for "Inspection and Study of Documents" using Code 011094; for "Reading/Classifying Technical Literature" using Code 112036; or for "Other Examining Activities" using Code 112036. If the Examiner's SPE will not approve of the time, the matter may be discussed with a Patent Office Professional Association (POPA) representative. In any event, the Applicants respectfully submit that the Examiner must consider the IDS filed January 8, 2004.

Claims 8-28 are pending in the present application, of which claims 8, 9, 13-15, 19 and 20 are independent. Claims 8-11, 13-15, 19-22, 24 and 26 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action continues to reject claims 8, 9, 19 and 20 as obvious based on the combination of U.S. Patent No. 5,942,767 to Na et al. and U.S. Patent No. 5,668,379 to Ono et al. Paragraph 4 of the Official Action continues to reject claims 10-12, 16-18, 21-26 and 28 as obvious based on the combination of Na, Ono and U.S. Patent No. 6,583,065 to Williams et al. Paragraph 6 of the Official Action continues to reject claims 13-15 and 27 as obvious based on the combination of Na, Ono and Williams. The Applicants respectfully submit that a *prima facie* case of

obviousness cannot be maintained against the independent claims of the present application, as amended.

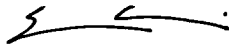
As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 8, 9, 13-15, 19 and 20 have been amended to recite that the former etching step is conducted continuously (claims 8, 9 and 13-15) or without changing an etching gas (claims 19 and 20). These features are described in the specification, for example, at page 17, line 10. Na, Ono and Williams, either alone or in combination, do not teach or suggest at least the above-referenced features of the present invention. Specifically, Na, Ono and Williams, either alone or in combination, do not teach or suggest etching a metal film, a second amorphous semiconductor film and a first amorphous semiconductor film continuously or without changing an etching gas.

Since Na, Ono and Williams do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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